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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,754	11/22/2000	Kathryn K. Lappegard	1189	3443

27310 7590 11/16/2001

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EXAMINER

BAUM, STUART F

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 11/16/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/718,754

Applicant(s)

LAPPEGARD ET AL.

Examiner

Stuart Baum

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Applicant is reminded that nucleotide sequences are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq (see MPEP 803.04 and 2434).

- I. Claims 1-3, 6-7, 11-12, 17, and 21 a method drawn to an isolated element that is capable of driving transcription in a seed using SEQ ID NO:1 (Jip1 promoter), classified in class 800 subclass 287 for example.
- II. Claims 1-2, 4, 6, 8, 11, 13, 16, 18, 21 a method drawn to an isolated element that is capable of driving transcription in a seed using SEQ ID NO:4 (Mi1ps3 promoter), classified in class 800 subclass 287 for example.
- III. Claims 1-2, 5, 6, 9, 11, 14, 16, 19, 21 a method drawn to an isolated element that is capable of driving transcription in a seed using SEQ ID NO:7 (Lec 1 promoter), classified in class 800 subclass 287 for example.
- IV. Claims 1-2, 6, 10, 11, 15, 16, 20, 21 a method drawn to an isolated element that is capable of driving transcription in a seed using SEQ ID NO:10 (Lec 1 terminator), classified in class 800 subclass 287 for example.
- V. Claim 22 a method drawn to the expression of Jasmonate protein using two regulatory elements, classified in class 530 subclass 370 for example.
- VI. Claims 22, 23 a method drawn to the expression of Myo-inositol-1-phosphate synthase 3 protein using two regulatory elements, classified in class 530 subclass 370 for example.

- VII Claim 22 a method drawn to the expression of Leafy cotyledon 1 protein using two regulatory elements, classified in class 530 subclass 370 for example.
- VIII Claims 24-33, and 37-39 a method drawn to two distinct regulatory elements capable of driving transcription in a seed using SEQ ID NO:1 & 10, classified in class 800 subclass 287 for example.
- IX Claims 24-33, and 37-39 a method drawn to two distinct regulatory elements capable of driving transcription in a seed using SEQ ID NO:4 & 10, classified in class 800 subclass 287 for example.
- X Claims 24-33, and 37-39 a method drawn to two distinct regulatory elements capable of driving transcription in a seed using SEQ ID NO:7 & 10, classified in class 800 subclass 287 for example.
- XI Claim 34 a method drawn to altering the phenotype of seeds, classified in class 800 subclass 290 for example.
- XII Claim 35 a method drawn to altering the fatty acid synthesis in seeds, classified in class 800 subclass 290 for example.
- XIII Claim 36 a method drawn to enhancing amino acid content of seeds, classified in class 800 subclass 290 for example.

Inventions I-IV are distinct from each other because the nucleic acid molecules specify distinct expression patterns and are themselves structurally distinct chemical compounds and are unrelated to one another.

Inventions I-IV and V-VII are distinct because Inventions V-VII are drawn to a method of expressing a specific protein using two distinct regulatory elements. The

elements specified in Inventions I-IV can be used to express other proteins than those specified in Inventions V-VII.

Inventions I-IV and VIII-X are distinct because Inventions VIII-X are drawn to methods of expressing in seeds using two specific elements in combination.

Applicant is reminded that nucleotide sequences are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq (see MPEP 803.04 and 2434).

Inventions I-IV are distinct chemical compounds and by themselves direct expression in seeds without interactions of another cis acting element.

Inventions I-IV and XI-XIII are distinct because Inventions XI-XIII are drawn to altering specific biochemical motifs of seeds using unspecific enzymes. Inventions I-IV can be used for specifying any number of proteins within seeds.

Inventions V-VII are distinct from each other because each invention is drawn to a method of expressing a specific protein (e.g. Jasmonate, Myo-inositol-1-phosphate synthase 3, and Leafy cotyledon 1, respectively) using two distinct regulatory elements.

Inventions V-VII and VIII-X are distinct because Inventions V-VII are drawn to the expression of specific proteins whereas Inventions VIII-X are drawn to a method of expressing any protein.

Inventions V-VII and XI-XIII are distinct because Inventions XI-XIII are drawn to altering specific biochemical motifs of seeds using unspecified enzymes. The Inventions I-IV are distinct and unrelated to those specified in Inventions XI-XIII.

Inventions VIII-X are distinct from each other because each invention is drawn to a method of expressing in seeds using two specific cis-acting regulatory elements.

Inventions VIII-X and XI-XIII are distinct because Inventions XI-XIII are drawn to altering specific biochemical motifs of seeds using unspecified enzymes whereas Inventions VIII-X are drawn to a method of expressing any protein using two specific cis-acting regulatory elements.

Inventions XI-XIII are distinct from each other because each invention is drawn to a method of altering specific biochemical motifs of seeds using unspecified enzymes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stuart Baum whose telephone number is (703) 305-6997. The examiner can normally be reached on Monday-Friday 8:30AM – 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell can be reached on (703) 308-4310. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Stuart Baum

November 7, 2001

ELIZABETH F. McELWAIN
PRIMARY EXAMINER
GROUP 1800

Elizabeth F. McElwain